

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Kamel KHALILI

Group Art Unit: 1643

Application No.: 10/517,710

Examiner: Sheela J. Huff

Filed: July 27, 2005

Confirmation No.: 4632

Title: METHOD OF CELL GROWTH INHIBITION WITH AGNOPROTEIN

REQUEST FOR PATENT TERM ADJUSTMENT

UNDER 37 C.F.R. § 1.705(b)

Mail Stop: PATENT EXT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a request for patent term adjustment for the allowed application above. The present request is timely filed under 37 C.F.R. § 1.705(b) with or before payment of the issue fee. The fee set forth in 37 C.F.R. § 1.18(e) is attached hereto. If any additional fees are required for consideration of this request, please charge the fees to our Deposit Account No. 50-0573.

Remarks begin on page 2.

R E M A R K S

The Office recently determined that the patent term adjustment should be 191 days. However, in view of recent legal developments and as explained below, the patent term adjustment should be 429 days.

1. The Office Applied an Improper Method of Calculating Patent Term Adjustment

The U.S. District Court for the District of Columbia recently held that the Office has been applying an improper method of calculating patent term adjustment. *Wyeth v. Dudas*, 580 F. Supp. 2d 138, 88 U.S.P.Q.2d 1538 (D.D.C. 2008). The Patent Office applied that improper method in the present case, resulting in a 238 day error.

The statute governing patent term adjustment, 35 U.S.C. § 154(b), defines certain periods of Patent Office delay that give rise to extensions of patent term. These include an “A period” concerning Office failure to comply with certain deadlines (defined by 35 U.S.C. § 1.54(b)(1)(A)) and a “B period” concerning Patent Office failure to issue a patent within 3 years after the actual filing date of a patent application (defined by 35 U.S.C. § 1.54(b)(1)(B)).

In *Wyeth*, the Patent Office argued that any administrative delay under the A period overlaps any 3-year maximum pendency delay under the B period, such that delays should be credited to the A period or B period, but not to both periods. The court rejected that argument. It held that delays may be credited to both the A period and B period, except to the extent those periods overlap by occurring on the same calendar days. In view of *Wyeth*, Petitioners request reconsideration of the patent term adjustment for the subject patent.

2. Calculation of the B Period

The patent term adjustment history from PAIR (attached as **EXHIBIT 1**) shows an adjustment of 0 days for the B period. However, the B period should be 238 days. Relevant dates for calculating the B period are listed below:

Attorney Docket No. 35926-0309-01-US (204136)
Application Serial No. 10/517,710
Request under 37 C.F.R. § 1.750(b) dated May 27, 2009

National Stage commenced under 35 U.S.C. § 371(b) or (f): December 10, 2004

3-year Anniversary of commencement of National Stage: December 10, 2007

Request for Continued Examination (RCE): August 5, 2008

The patent is set to issue on September 15, 2009, 645 days after the 3-year anniversary of the filing date. However, time consumed by examination after a RCE does not count toward the B period. In this case, 407 days elapsed from the filing of a RCE until the patent issued. So the B period is calculated as follows:

$$645 \text{ days} - 407 \text{ days} = 238 \text{ days.}$$

That is a difference of 238 days when compared with the Patent Office's improper 0 day calculation.

3. The Director Should Add 238 More Days to the Patent Term Adjustment

Considering the corrected B period, the Director should add 238 more days to the patent term adjustment. B period delays occurring on the same calendar days as A period delays constitute 0 days.

4. Presence or Absence of a Terminal Disclaimer

The patent is not subject to any terminal disclaimer that would impact such a correction.

Attorney Docket No. 35926-0309-01-US (204136)
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Request under 37 C.F.R. § 1.750(b) dated May 27, 2009

CONCLUSION

No fees are believed due; however, if any fees are required for consideration of this request, please charge the fees to our Deposit Account No. 50-0573.

Date: May 27, 2009

Respectfully submitted,

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For: DANIEL A. MONACO

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Attorney Docket No. 35926-0309-01-US (204136)
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Exhibit 1

Patent Term Adjustment calculation from PAIR

10/517,710	METHOD OF CELL GROWTH INHIBITION WITH AGNOPROTEIN	04-17-2009::14:36:30
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Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/517,710

Filing or 371(c) Date:	07-27-2005	USPTO Delay (PTO) Delay (days):	324
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	133
Post-Issue Petitions (days):	+0	Total PTA (days):	191
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
03-06-2009	Mail Notice of Allowance		
03-04-2009	Document Verification		
03-04-2009	Notice of Allowance Data Verification Completed		
01-27-2009	Date Forwarded to Examiner		
01-05-2009	Response after Non-Final Action		
10-08-2008	Mail Non-Final Rejection		
10-07-2008	Non-Final Rejection		
08-05-2008	Information Disclosure Statement considered		
08-05-2008	Information Disclosure Statement (IDS) Filed		
08-14-2008	Date Forwarded to Examiner		
08-14-2008	Date Forwarded to Examiner		
08-05-2008	Request for Continued Examination (RCE)	47	
08-14-2008	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)		↑
08-05-2008	Information Disclosure Statement (IDS) Filed		↑
08-05-2008	Workflow - Request for RCE - Begin		↑
02-11-2008	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		↑
03-19-2008	Mail Final Rejection (PTOL - 326)		↑
03-14-2008	Final Rejection		
03-06-2008	Date Forwarded to Examiner		
02-11-2008	Response after Non-Final Action	86	
02-11-2008	Request for Extension of Time - Granted		↑
08-17-2007	Mail Non-Final Rejection	324	
08-14-2007	Non-Final Rejection		↑
07-27-2005	Reference capture on IDS		↑
12-05-2005	Cleared by OIPE CSR		↑
11-24-2005	Cleared by OIPE CSR		↑
11-24-2005	Cleared by OIPE CSR		↑
11-24-2005	Cleared by OIPE CSR		↑
11-24-2005	Cleared by OIPE CSR		↑
11-24-2005	Cleared by OIPE CSR		↑

11-18-2005	IFW TSS Processing by Tech Center Complete	↑
11-18-2005	Case Docketed to Examiner in GAU	↑
07-27-2005	371 Completion Date	↑
11-01-2005	Application Dispatched from OIPE	↑
11-02-2005	Notice of DO/EO Acceptance Mailed	↑
07-27-2005	Additional Application Filing Fees	↑
07-27-2005	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	↑

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